

Notice of Allowability

Application No.

10/017,695

Applicant(s)

LIEB ET AL.

Examiner

Tamthom N. Truong

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to Terminal Disclaimer of 4-28-04.
2. ☒ The allowed claim(s) is/are 1-5 and 22-26.
3. ☐ The drawings filed on _____ are accepted by the Examiner.
4. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some* c) ☐ None of the:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 08/945,664.
3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
- (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
- 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
- (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|---|--|
| 1. <input type="checkbox"/> Notice of References Cited (PTO-892) | 5. <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 6. <input checked="" type="checkbox"/> Interview Summary (PTO-413),
Paper No./Mail Date <u>attached</u> . |
| 3. <input type="checkbox"/> Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date _____ | 7. <input checked="" type="checkbox"/> Examiner's Amendment/Comment |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit
of Biological Material | 8. <input type="checkbox"/> Examiner's Statement of Reasons for Allowance |
| | 9. <input checked="" type="checkbox"/> Other <u>"Allowable Subject Matter"</u> . |

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Examiner's Amendment

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Mr. Howard C. Lee on 19 May 2004.

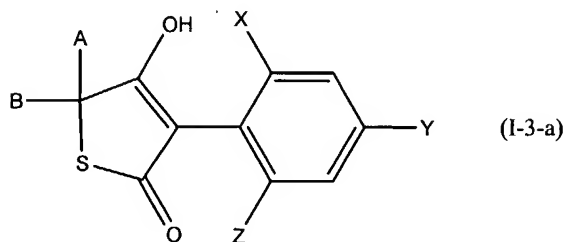
In the Claims

In **claim 2**, (page 9, second to last line of Preliminary Amendment of 14 December 2001), substitute the misspelled word "memebered" with ---membered---.

Substitute claim 5 with amended claim 5 below:

Claim 5. Process for the preparation of compounds of the formula (I) according to Claim 1, characterized in that

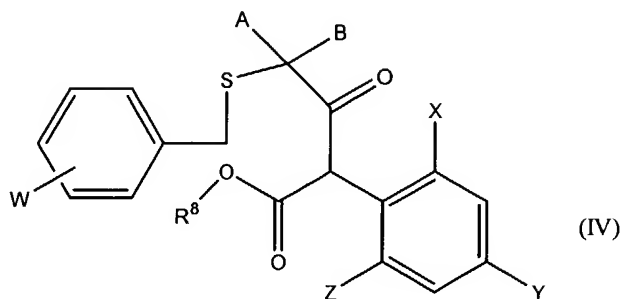
a compound of the formula (I-3-a)



in which

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A, B, X, Y and Z are as defined in claim 1,
are obtained when a compound of the formula (IV)



in which

A, B, X, Y, Z and R⁸ are as defined in claim 1 and

W represents hydrogen, halogen, alkyl or alkoxy,

are subjected to intramolecular cyclization, optionally in the presence of a diluent
and in the presence of an acid.

Allowable Subject Matter

Applicant's Terminal Disclaimer of 4-28-04 has overcome the previous ODP rejection based on US 6,380,246 B1. Therefore, said rejection is withdrawn herein. The above Examiner's Amendment has also further clarified claims 2 and 5. With no other outstanding rejection, pending claims 1-5, and 22-26 are allowed.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamthom N. Truong whose telephone number is 571-272-0676. The examiner can normally be reached on M-F (~10 am ~ 6:30 pm).

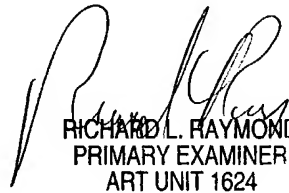
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mukund Shah can be reached at 571-272-0674. If you are unable to reach Dr. Shah within a 24 hour period, please contact James O. Wilson, Acting SPE of 1624, at 571-272-0661.

The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-1600.



T. Truong

June 1, 2004



RICHARD L. RAYMOND
PRIMARY EXAMINER
ART UNIT 1624

Examiner's Amendment

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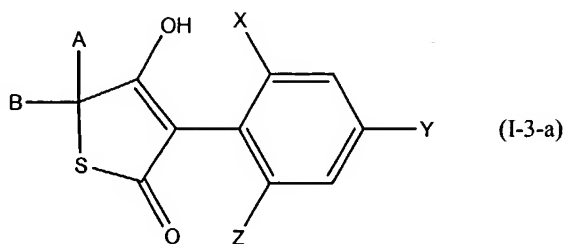
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Claim 5. Process for the preparation of compounds of the formula (I) according to Claim 1, characterized in that

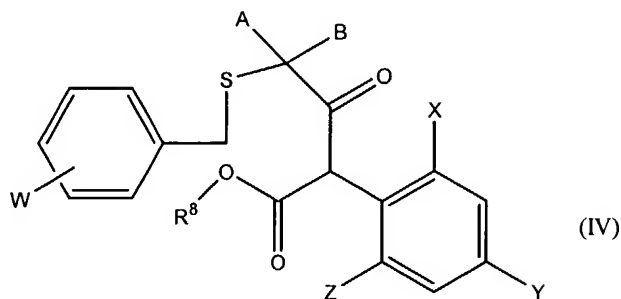
a compound of the formula (I-3-a)



in which

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A, B, X, Y and Z are as defined in claim 1,
are obtained when a compound of the formula (IV)



in which

A, B, X, Y, Z and R^8 are as defined in claim 1 and

W represents hydrogen, halogen, alkyl or alkoxy,

are subjected to intramolecular cyclization, optionally in the presence of a diluent
and in the presence of an acid.

Allowable Subject Matter

Applicant's Terminal Disclaimer of 4-28-04 has overcome the previous ODP rejection based on US 6,380,246 B1. Therefore, said rejection is withdrawn herein. The above Examiner's Amendment has also further clarified claims 2 and 5. With no other outstanding rejection, pending claims 1-5, and 22-26 are allowed.